REMARKS

I. Introduction

In the Office Action: (1) claims 1-5 and 11-13 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2001/0054087 to Flom et al. (hereinafter "Flom"); and claims 6-10 and 14-17 were rejected under 35 U.S.C. §103(a) as being obvious over Flom in view of U.S. Publication No. 2002/0052824 to Mahanti et al. (hereinafter "Mahanti"). The rejections were made final.

Applicant gratefully acknowledges the courtesies extended to Applicant's representatives during the April 7, 2004 telephone interview. The sum and substance of the interview is contained in the above amendments and the following remarks.

This response is submitted concurrently with a Request for Continued Examination (RCE). Based on the April 7, 2004 interview with the Examiner, Applicant amends the claims to better articulate novel aspects of the claims. In particular, Applicant has amended independent claims 1 and 11 and added new independent claim 18. Claims 1-18 are now pending. Applicant believes that the claims as amended are in condition for allowance.

II. Amended Claims 1 and 11

Claims 1 and 11 have been amended to recite that the mobile cache is "disposed between the wireless network and the Internet." It is respectfully submitted that this feature is not disclosed or taught in the prior art of record. In particular, the Examiner's interpretation of portable web pages, the portable internet server, or the content manufacturing system for purposes of rejecting claims 1 and 11 precludes Flom from teaching the above claim limitation. Fig. 9 of Flom shows that the portable internet server and content manufacturing system of Flom are not positioned between the Internet and the wireless device. Therefore, for at least this reason, claims 1, 11, and their dependent claims (claims 2-10 and 12-17) are believed to be in condition for allowance.

III. New Claim 18

In the April 7, 2004 telephone interview, the Examiner suggested that the concepts in the application relating to a change trigger may contain patentable subject matter.

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Accordingly, new independent claim 18 has been added. Claim 18 includes the limitation of dynamically composing user-specific information <u>while</u> a change trigger monitors changes in the object database and triggers output delivery when a <u>number</u> of information changes in the object database reaches a predetermined threshold. It is respectfully submitted that this feature is not disclosed or taught in the prior art of record. For at least this reason, claim 18 is believed to be in condition for allowance. Patentable aspects of the change trigger are discussed in more detail below.

IV.   Rejection of claims 1-5 and 11-13 under 35 U.S.C. 102(e) over Flom

In addition to the foregoing reasons for patentability, Applicant believes there are additional reasons that the claims are patentable over the prior art of record. In the Office Action, the Examiner rejected Claims 1-5 and 11-13 under 35 U.S.C. § 102(e) as being anticipated by Flom. However, the Office Action has failed to establish a *prima facie* case of anticipation because Flom fails to teach every limitation recited in the claims. It is a fundamental principle of patent law, that a claim is not anticipated unless each and every element of the claimed invention is present in the cited reference. Flom fails to teach several claim limitations. Accordingly, for at least the reasons presented below, Applicant respectfully requests that the rejections under § 102(e) be withdrawn.

A.   Flom does not disclose dynamically composing user-specific information as recited in claims 1 and 11.

In regards to claim 1, the Examiner asserts on page 5 of the Office Action that paragraphs 7-9 and 67 of Flom disclose dynamically composing user-specific information as personalized, user-specific output based on data in the object database and the user profile. In relation to claim 11, the Examiner asserts on page 8 of the Office Action and page 2 of the Advisory Action that paragraphs 58-59 of Flom disclose the same functionalities. However, Flom relies on static caching and fails to teach dynamically composing user-specific information as recited in claims 1 and 11. Claim 1 recites, in part:

> a dynamic information composer coupled to the object database and
> the user profile database; and
>> wherein the dynamic information composer *dynamically*
>> *composes user-specific information* as a personalized, user-specific

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output *based on data in the object database and the user profile* while simultaneously reducing network traffic.

(See Claim 1, emphasis added.) Thus, claim 1 is directed to dynamically composing user-specific information based on data in the object database and the user profile. In other words, the claimed mobile cache can compose personalized data stored by the object database based on a user profile. Accordingly, cached data can be personalized for multiple users without having to download new data from an origin server for a different user profile. Moreover, amended claims 1 and 11 recite that dynamic composition is performed at the mobile cache, which cache is disposed between the wireless network and the Internet.

In contrast to the claims, Flom discloses a static caching system that does not personalize cached data at a mobile cache that is disposed between the wireless network and the Internet. Flom teaches that relevant content packages are created at a content manufacturing system (Fig. 9; paragraphs 7, 9, 31, 35, 44, 66, 67, 69), which manufacturing system the Examiner asserts is an origin server (Office Action, page 5).

In Flom's system, if a user makes a request and the requested content is not available at a portable cache, the portable cache's static data must be updated by newly requested and downloaded data created by the content manufacturing system. Thus, Flom's teachings appear to be limited to creating content packages only at a manufacturing source. In other words, Flom teaches a static caching system lacking dynamic caching functionality.

Inasmuch as the Examiner interprets dynamic composition to occur at the content manufacturing system or the portable internet server of Flom, the Examiner's interpretation does not teach the limitation of dynamically composing user-specific information at a mobile cache that is <u>disposed between the wireless network and the Internet.</u> Fig. 9 of Flom shows the manufacturing system and the portable internet server as <u>not</u> being disposed between a wireless device and the Internet.

As Applicant argued on pages 7-8 of the Amendment dated October 10, 2003 (hereinafter the "October 10 Amendment), Flom's teachings are limited to static caching systems as described in the Background of the Invention of the present application:

"The information from the cache reaches the user faster and also relieves the network from the burden of the additional traffic that would have occurred if the Web page information had to be re-transmitted to the wireless device.

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> Currently, known-caching schemes in wireless applications, however, can deal
> only with static data and cannot generate any information according to user-
> specified parameters" Page 1, lines 19-23.

Thus, Flom exemplifies the state of the art discussed in the Background. Flom discloses the formation of content packages that may be stored on electronic computer media such as a storage system 14 (paragraph 53). Then, upon a user-request, the content distribution system 16 distributes the *pre-defined* content packages to portable web sites 18 for use by community users of portable electronic devices 94 (paragraph 55). However, if the static content packages do not contain requested information, the content distribution system 16 cannot manipulate the content packages to fit user requests. In short, the content packages of Flom cannot be personalized at a location between the Internet and the wireless device. Instead, the content packages are updated with content packages created and sent over the Internet by the content manufacturing system 90. Thus, Flom teachings of caching functionalities appear limited to distributed pre-defined content packages.

On page 3 of the Office Action, the Examiner responded to Applicant's argument that Flom "does not teach the dynamic nature of the invention" (October 10 Amendment, page 10). The Examiner points out that "Flom teaches preparing relevant content packages for users when requested relevant content packages are not present on server 92 (cache 92A), and forwarding them automatically to requesting user." As mentioned above, the content packages of Flom are prepared only at the content manufacturing system 90.

Inasmuch as the Examiner asserts that the portable web sites of Flom (Advisory Action, page 2) somehow read on the claims, the portable websites of Flom are taught to be generated at on the Internet side of Flom's system. Thus, the portable web sites cannot read on the claim limitation related to dynamic composition occurring at the mobile cache disposed between the Internet and the wireless device. Accordingly, the cited teaching of Flom does not relate the dynamic features recited in claims 1 and 11.

Further, Flom contains no disclosure of using its personal information object 10C to manipulate its information objects 10A or 10B. Flom does not teach any dynamic composition performed by the server 92 (cache 92A). Accordingly, Flom teaches a static caching system that is limited to distributing relevant *pre-defined* content packages. Therefore, claims 1, 11, and their dependent claims (claims 2-10 and 12-17) are in condition

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for allowance because Flom does not disclose "dynamically compos[ing] user-specific information" as recited in independent claims 1 and 11.

B.   Flom does not disclose a mobile cache including a user profile database and an object database as recited in claim 1.

On page 5 of the Office Action, the Examiner asserts that Flom discloses a mobile cache (Fig. 9, 92A), a user profile database (Fig. 1, source object 10), and an object database (paragraphs 6-9, 489-53, and 57-62). However, the support cited by the Examiner does not disclose a mobile cache *including* a user profile database and an object database as recited in claim 1. As shown in Fig. 1 of Flom, the source objects 10 are used by the content manufacturing system 90 to form content packages for distribution by the content distribution system 16 (paragraphs 53-55). The source objects 10 taught by Flom are not a user profile *database*. Moreover, Flom does not teach a mobile cache including both an object database and a user profile database. Flom's failure to teach dynamic caching features further evidences Flom's lack of a mobile cache including both an object database and a user profile database.

Moreover, inasmuch as the Examiner interprets the intelligent cache 92A of Flom to be a modile cache as claimed, Flom cannot anticipate every element of claim 1. In particular, the intelligent cache of Flom is not disposed between the wireless device and the Internet (See Flom, Fig. 9). Therefore, claim 1 and its dependent claims (claims 2-10) are in condition for allowance.

C.   Flom does not disclose a change trigger as recited in claim 5.

On pages 2 and 7 of the Office Action, the Examiner asserts that paragraphs 31, 43-44, and 53-39 of Flom teach the change trigger as recited in claim 5. However, there is no teaching in Flom of "the change trigger monitor[ing] changes in the object database and trigger[ing] output delivery when a number of information changes in the object database reaches a predetermined threshold" (claim 5). The closest Flom comes to any such teaching is automatically notifying a user of a new or newly reviewed restaurant in a geographic area that matches criteria input by the user (paragraph 59). However, apprising a user of a new restaurant does not teach the claim limitation of monitoring when a *number* of information

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changes in the object database reaches a predetermined threshold. Flom does not disclose monitoring a number of information changes or when that number reaches a predetermined threshold. The Advisory Action failed to respond to this argument concerning monitoring a number of changes. Therefore, claim 5 is in condition for allowance.

Claim 13 is also in condition for allowance for the same reasons. Specifically, claim 13 recites the steps of monitoring a number of information changes in the object database and triggering a delivery once the number of information changes reaches a predetermined threshold.

Moreover, in claim 5, the change trigger is claimed as part of the mobile cache. Flom does not teach a change trigger as part of a mobile cache that is disposed between the wireless device and the Internet. As mentioned above, the portable internet cache of Flom is not disposed between the wireless device and the Internet (See Fig. 9 of Flom). Therefore, claim 5 is in condition for allowance.

V. Rejection of claims 6-10 and 14-17 under 35 U.S.C. 103(a) as being obvious over Flom in view of Mahanti.

In the Office Action, the Examiner rejected claims 6-10 and 14-17 under 35 U.S.C. § 103(a) as being obvious over Flom in view of Mahanti. The arguments made above in connection with the Flom are equally applicable here. Accordingly, claims 6-10 and 14-17 are in condition for allowance at least as dependents from amended independent claims 1 and 11.

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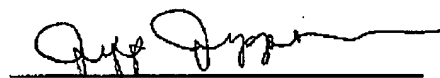Docket No.: 00-8018
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VI. **Conclusion**

In view of the foregoing, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of the paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 07-2347.

Respectfully submitted,

Dated: _May 5, 2004_   By: _____

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